Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TOSHIYUKI TOYOFUKU, MASAFUMI YAMASAKI, NOBUHIDE DOTSUBO, TOSHINOBU HARUKI, and HIDETO HAYASHI

Appeal No. 2003-2066
Application No. 09/096,395

ON BRIEF

Before HAIRSTON, RUGGIERO, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

A patent examiner rejected claims 13-18, 20, and 22-28. The appellants appealed therefrom under 35 U.S.C. § 134(a). We affirmed-in-part. *Ex parte Toyofuku,* No. 2003-2066, slip op. at 1 (Bd.Pat.App. & Int. Feb. 17, 2005). Pursuant to 37 C.F.R. § 41.52(a)(1), the appellants now ask us to reconsider our affirmance of claims 18, 20, and 25-28. (Req. Reh'g at 1.)

OPINION

Rather than reiterate the positions of the appellants *in toto*, we focus on their point of contention. To wit, they argue that "[t]here is no prior art of record that actually contemplates or discloses the concept that where there is insufficient memory available on the currently utilized removable memory, the system would still use that insufficient media for a portion of the data and allow the remaining portions to be stored on another, second media." (*Id.* at 3.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

1. Claim Construction

"Analysis begins with a key legal question — *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art," *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1021, 1034 (Fed. Cir. 1994) (citing *In re* Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)); however, "limitations are not to be read into the claims from the specification." *In re*

Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, independent claim 18 recites in pertinent part the following limitations: "a first detachable recording medium for recording image information corresponding to a first panoramic image frame of a set of panoramic image frames photographed in the panoramic mode, and a second detachable recording medium for recording image information corresponding to a subsequent panoramic image frame in the set of panoramic image frames photographed in the panoramic mode when a capacity of the first recording medium is insufficient to record all of the images of the set of panoramic image frames. . . ." Independent claims 25 and 27 recite similar limitations. Considering these limitations, claims 18, 25, and 27 require recording a first panoramic image frame of a set of panoramic image frames in a first removable memory and recording a subsequent panoramic image frame **of the same set** of panoramic image frames in a second removable memory.

Independent clam 20, however, recites no such limitations. Reciting only a single "recording medium," it does not require plural removable memories.

2. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner admits that "Fujimori does not disclose a panoramic camera. . . ." (Examiner's Answer at 5.) For its part, Moghadam discloses "an electronic panoramic camera 10," col. 2, l. 58, that includes "a panoramic mode switch 20." *Id.* at ll. 61-62. "The mode switch 20 allows operation of the camera 10 in a normal mode for producing images of conventional format or in a panoramic mode for producing images tagged for panoramic processing. . . ." *Id.* at ll. 63-67. "The view finder 16 [of Moghadam's camera] includes a panoramic alignment means shown as two spaced indicia 22, 24." *Id.* at ll. 62-63. "In operation, as shown in FIG. 2, the

photographer notes the alignment of the first indicia 22 with a first feature in the scene and takes the first exposure (as indicated by exposure position A). The photographer then displaces the field of view of the camera 10 sufficiently to align the alternate indicia, that is, the second indicia 24, with the first feature (as shown by exposure position B), and takes the second exposure. This process can then be repeated as desired to produce a panoramic image of any width." Col. 3, ll. 1-9.

"As shown in the camera block diagram of FIG. 4, the analog output of the image sensor 14 is converted into a digital image signal by an analog/digital (A/D) converter 30 and thereafter applied to a control processor 32." *Id.* at ll. 21-24. "The digital image from the control processor 32 is then applied to the output section 34, which may include a storage device such as a resident (buffer) memory, a removable memory device (such as an integrated circuit memory card), a magnetic medium, or the like." *Id.* at ll. 28-32.

More specifically, "[t]he control processor 32 generates the digital image signal in a digital format such as shown in FIG. 5, that is, including a header 52 and an image trailer 54. According to the invention, a sequence of such image trailers, and their corresponding headers, may be used to form a sequence of panoramic image segments." *Id.* at ll. 51-56. "The function of the header 52 is to tag image segments for

downstream panoramic processing, and to provide other data useful in the subsequent concatenation of the panoramic image segments." *Id.* at ll. 57-59. Although the secondary reference records panoramic image frames on its removable memory device, we are unpersuaded that it can record subsequent panoramic image frame **of the same set** of panoramic image frames in a second removable memory device.

The examiner does not allege, let alone show, that the addition of Udagawa cures the aforementioned deficiency of Fujimori and Moghadam. Absent a teaching or suggestion of recording a first panoramic image frame of a set of panoramic image frames in a first removable memory and recording a subsequent panoramic image frame of the same set of panoramic image frames in a second removable memory, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 18; of claim 25; of claim 26, which depends from claim 25; of claim 27; and of claim 28, which depends from claim 27.

Being unpersuaded of error in the examiner's rejection of claim 20, however, we maintain our affirmance of the obviousness rejection of that claim.

CONCLUSION

In summary, we grant the appellants' request to reverse the rejection of claims 18 and 25-28 under 35 U.S.C. § 103(a). In contrast, we deny his request to reverse the rejection of claim 20 under § 103(a).

"Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs and request for rehearing. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED-IN-PART

KENNETH W. HAIRSTON
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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